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Joachim Koerner

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EXAMINER

PATEL, NIHIR B

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* JOACHIM KOERNER, MICHAEL HELMLINGER, HOLGER  
SHUERLE, and RENE BOMMER

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Application No. 10/777,257  
Technology Center 3700

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Mailed: May 22, 2009

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Before CAROLYN L. JOHNSON, *Supervisory Paralegal Specialist*.  
CAROLYN L. JOHNSON, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on January 14, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

**APPEAL BRIEF, GROUNDS OF REJECTION**

A review of the file finds that the grounds of rejection of the claims as provided in the Appeal Brief filed June 15, 2007 under the heading “Grounds of rejection to be reviewed on appeal” is unclear and/or is not consistent with the grounds of rejection of claims of record. The grounds of rejection of the claims as provided in the Appeal Brief must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified.

A review of the last Office action, including any mailed Advisory Action(s) finds that claims 10 is rejected under 35 U.S.C. § 112, first paragraph with claims 12, 14 and 15 being withdrawn; whereas Appellants have improperly included withdrawn claims 12, 14 and 15 in the rejection under 35 U.S.C. § 112, first paragraph.

Correction of the Grounds of rejection to be reviewed on appeal for all claims is required.

**EXAMINER’S ANSWER**

**GROUNDS OF REJECTION TO BE REVIEWED UPON APPEAL**

A review of the file finds that the grounds of rejection to be reviewed on appeal of the claims as provided in the Examiner’s Answer mailed

October 3, 2007 under the heading “Grounds of rejection to be Reviewed on Appeal” is either unclear or is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection to be reviewed on appeal as provided in the Examiner’s Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Furthermore, the examiner must provide a clear statement of whether examiner agrees or disagrees with the statement of grounds of rejection to be reviewed as set forth in the brief and an explanation of any disagreement. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

A review of the Examiner’s Answer finds that it is unclear what rejected claims are on appeal as compared to the Appeal Brief and/or the Examiner’s Answer does not clearly address differences between rejections set forth in the Examiner’s Answer and those addressed in the brief.

Clarification of the record is required for all Grounds of rejection to be reviewed on appeal for all claims.

#### EXAMINER’S ANSWER, GROUNDS OF REJECTION

A review of the file finds that the grounds of rejection of the claims as provided in the Examiner’s Answer mailed October 3, 2007 under the

heading “Grounds of rejection” is not consistent with the grounds of rejection of claims set forth in the last Office action of record. The grounds of rejection of the claims as provided in the Examiner’s Answer must be consistent with the last Office action of record, including any Advisory action responsive to any after final submissions. Each Grounds of rejection to be reviewed on appeal must be identified and any new grounds of rejection must be provided under a separate heading “New Grounds of Rejection” in the Examiner’s Answer and must include the approval of the TC Director or his/her designee. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 and 1207.03 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

Specifically, the Examiner’s Answer sets forth a rejection of claims 10, 12, 14 and 15 under 35 U.S.C. § 112 first paragraph; whereas the last Office action, including any mailed Advisory Action(s) finds that claims 12, 14 and 15 have been withdrawn.

Correction of all Grounds of rejection for all claims is required.

It is also noted that the Examiner's answer mailed on October 3, 2007, also incorrectly states the date of the final Rejection as November 30<sup>th</sup>, 2005, instead of May 16, 2005.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

1) to vacate the Examiner's Answer mailed October 3, 2007;

2) to generate a new Examiner's Answer setting forth the correct Grounds of rejection to be reviewed on appeal and to correct other sections of the Answer as may be required;

3) to generate a new Examiner's Answer setting forth the correct Grounds of rejection and to correct other sections of the Answer as may be required;

4) to include the approval of the TC Director or his/her designee (as required for any new grounds of rejection); and

5) such further action as may be required.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

CLJ/lp

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